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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,062	03/30/2006	Samuel J. Maggio	ICM-001CP	9779

51414 7590 02/19/2010

GOODWIN PROCTER LLP  
PATENT ADMINISTRATOR  
53 STATE STREET  
EXCHANGE PLACE  
BOSTON, MA 02109-2881

EXAMINER
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HURLEY, KEVIN

ART UNIT	PAPER NUMBER
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3611

NOTIFICATION DATE	DELIVERY MODE
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02/19/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/574,062	<b>Applicant(s)</b> MAGGIO, SAMUEL J.	
	<b>Examiner</b> KEVIN HURLEY	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-24, 26-29 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-14 and 18-24 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7, 11-14, and 18-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins 4,765,773.

Hopkins (Figs 1-4) discloses a surface traversing apparatus comprising:

a frame 27 forming a chamber;

a seal having a closed seal perimeter defining an opening of the chamber, the seal perimeter having a plurality of rollers 23-26 mounted in parallel on opposite sides of the frame and rolling relative to the chamber; and

a drive 10 powering at least a portion of the seal to move the apparatus relative to the surface;

the rollers comprising a compressible outer surface;

wherein a portion of the seal perimeter comprises two tracks 29 mounted in parallel on opposite sides of the frame;

the seal perimeter comprising a quadrilateral;

a processor 16 for controlling the apparatus;

Art Unit: 3611

and a means 21 for maintaining the apparatus in contact with the surface (using its weight).

3. Claims 1-4, 7, 11, 14, 18, 21-22, 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Ochiai 4,785,902.

Ochiai discloses a surface traversing apparatus comprising:

a frame 1 forming a chamber;

a seal comprising at least one roller 7 having a compressible outer surface and having a seal perimeter having at least a portion for rolling; and

a drive 32 powering at least a portion of the seal to move the apparatus relative to the surface;

wherein a portion of the seal comprises a track 7;

means (vacuum col. 4 line 28).

#### ***Allowable Subject Matter***

4. Claims 26-28 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

5. Regarding the rejection of the claims under 35 U.S.C. § 102(b) as being anticipated by Hopkins, applicant has argued that “Hopkins does not teach or suggest an apparatus including a seal for maintaining "a vacuum seal with the surface sufficient to adhere

Art Unit: 3611

the apparatus to the surface," and, in fact, does not include any seal "sufficient to adhere the apparatus to the surface." However, this functional language is merely intended use. No actual structure is recited which differs from Hopkins. Certainly nothing that applies a vacuum.

Applicant also argues that Hopkins fails to recite a drive powering at least a portion of the seal to move the apparatus relative to the surface. However, the drive unit 10 of Hopkins meets this broad language. The claims fail to recite any specifics as to the drive.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN HURLEY whose telephone number is (571)272-6646.

The examiner can normally be reached on Monday-Friday 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin Hurley/  
Primary Examiner, Art Unit 3611

February 12, 2010